



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JGJR.: 06-04

Paper No: 24

PAUL, HASTINGS,
JANOFSKY & WALKER LLP
P.O. BOX 919092
SAN DIEGO CA 92191-9092

COPY MAILED

JUL 01 2004

OFFICE OF PETITIONS

In re Application of

Boehm, et al.

Application No. 08/479,920

Filing Date: 7 June, 1995

Attorney Docket No. 224/216

:

:

:

DECISION ON PETITION

This is a decision on the petition filed on 12 January, 2004, and resubmitted on 21 April, 2004, alleging, *inter alia*, improper abandonment by the Office and requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is

DISMISSED,

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.181, or 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) **must be submitted within two (2) months from the mail date of this decision**. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Issue Fee Due mailed on 28 July, 1998, with reply due on or before 28 October, 1998;
- the application went abandoned by operation of law after midnight 28 October, 1998;
- the Office mailed a Notice of Abandonment on 6 May, 1999;
- Petitioner alleges:
 - the filing on 18 October, 1998, of a petition to withdraw from issue in order that an interference might be declared—an allegation that is not evidenced/supported with a date-stamped receipt card;
 - acknowledgment by the Examiner of Office error in the abandonment—an allegation that is unsupported in the documentation;
 - agreement of the Examiner on 10 August, 1999, to withdraw the holding of abandonment—an allegation that is unsupported in the documentation;
- the foregoing events as narrated by Petitioner occurred between 18 October, 1998, and 10 August, 1999, however, Petitioner appears to have taken no further action until 14 May, 2003, when Petitioner's office authorized persons to inspect the record (the Power to Inspect was then filed with the Office on 22 May, 2003);
- Petitioner makes no showing of the reasons/bases for delaying:
 - three (3) years and nine (9) months between the August 1999 meeting and authorized inspection of the record; and
 - almost eight (8) months between the authorized inspection and the filing of the instant petition on 12 January, 2004.

Petitioner alleges and the record reflects that the application was allowed on 28 July, 1998, however, Petitioner does not allege—and the record does not reflect—that the Issue Fee was paid in the instant matter.

Thus, even if a petition to withdraw from issue was filed in the instant matter, such a petition was not a proper reply to the Notice of Allowance and Issue Fee Due.

Notably, the record, by virtue of the Interview Summary states: "Case to be revived. Will come in with claim to invoke (sic) an interference with Davies or amend claim to be allowable."

Petitioner makes no allegation that an amendment was in fact filed—timely or otherwise, and makes no showing of such filing.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: Changes to Patent Practice and Procedure, Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶ And petitions calling upon the authority of the Commissioner to act, such as that under 37 C.F.R. §1.181,⁷ require diligence as to their filing—i.e., the petition must be filed within two months of the action complained of.

Allegations as to the Request to Withdraw
the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁸

Petitioner, as one registered to practice before the Office, is aware that:

- all matters before the Office must be in writing (See: 37 C.F.R. §1.2);
- the proper manner in which to address a request to withdraw the holding of abandonment is via a petition under 37 C.F.R. §1.181, and that is to be instituted by the applicant (See: MPEP §711.03(I));

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ The regulations at 37 C.F.R. §1.181 provide:
§ 1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:
(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
(e) Oral hearing will not be granted except when considered necessary by the Commissioner.
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.
[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

⁸ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

- the regulations at 37 C.F.R. §1.181 specify that a petition is to be filed within two (2) months of the Office action complained of; and
- it is the responsibility of the practitioner/Counsel to ensure that the substance of the interview is preserved of record, and the Interview Summary form serves that function (See: MPEP §713.04).

While Petitioner submits a document suggesting that a Petition to Withdraw from Issue was drafted and may have been mailed, Petitioner offers no evidence that the paper was filed with the Office.

Moreover, a petition to withdraw from issue is not a proper reply to the Notice of Allowance and Issue Fee Due before payment of the Issue Fee.

And Petitioner makes no showing as to any other reply both timely and proper to the Notice of Allowance and Issue Fee Due before the due date, 28 October, 1998.

Thus, it is clear that after midnight 28 October, 1998, the instant application went abandoned by operation of law.

While Petitioner alleges that the “Examiner recognized that the Notice of Abandonment had been issued in error and agreed to revive the case,” (Petition at page 2):

- the commentary at MPEP §711.03(I) makes clear that there is a distinction between withdrawal of the holding of abandonment and revival of an application; and
- the Interview Summary states that the case will “be revived”—a condition that requires the applicant to file a petition under 37 C.F.R. §1.137, pay a fee, file a reply, make a statement and/or showing of unintentional or unavoidable delay, and (in this case) submit a Terminal Disclaimer and fee.

Petitioner alleges that an amendment was to be filed to provoke an interference, but:

- there is no documentation provided to suggest this ever was done;
- moreover, the Interview Summary expressly states that the applicant will act either “to invoke an interference . . . or amend claim to be allowable.”

Again, Petitioner presents no evidence indicating that either of these alternatives occurred at all, much less before abandonment.

But that is of no matter because the application went abandoned by operation of law after midnight 28 October, 1998, and by Petitioner's own acknowledgment the events described surrounding the interview with the Examiner did not occur until August 1999—almost ten (10) months later.

Despite the various allegations, Petitioner has made no showing and provided no documentary support that the Office erred in this matter.

And, notwithstanding the regulatory requirements, Petitioner waited years to act.

Thus, Petitioner fails to satisfy the burden under 37 C.F.R. §1.181

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

ALTERNATIVE VENUE

It appears unlikely that Petitioner likely is able to make a showing to support a request to withdraw the holding of abandonment or an allegation of unavoidable delay. Therefore, Petitioner's only alternative to irretrievable abandonment is to:

- file a petition under 37 C.F.R. §1.137(b) with fee:
- satisfy the “reply” requirement under the regulation;
- satisfy the “showing” requirement under the regulation as to unintentional delay with a detailed discussion as to all the causes which contributed to the delay (supported with appropriate evidence):
 - supporting documentation should include, but not be limited to, docket records, tickler reports, and file jacket entries for this application, and documents regarding the alleged cause of the delay and copies of any documents referred to in Petitioner's statement as to the cause of the delay are required;
 - Petitioner should identify the party(ies) responsible for management/prosecution of the application:

—a showing must be made (with supporting documents) outlining the efforts made to ensure diligent attention to the instant matter, including scheduling and calendaring information, appointment of an individual with the authority to act herein, and detailing of the causes for a failure in that process;

- satisfy the Terminal Disclaimer (Form PTO/SB/63, copy enclosed) requirement (with fee) under the regulation.

Thus, Petitioner may wish to supplement the petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

Petitioner is cautioned that failure to reply promptly may be considered intentional delay and result in irretrievable abandonment.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents⁹
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306 (IFW Formal Filings)
ATTN.: Office of Petitions

By hand: Customer Service Window
Lobby/Room 1B03
Crystal Plaza Two
2011 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁹ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.